

Remarks:

3. Claims 1 and 3-6 are rejected under the judicially created doctrine of obviousness-type double patenting. It is the understanding of the applicant that this rejection is temporarily held in abeyance pending the disposition of the claims. If applicant's understanding is inaccurate, please advise the status of this rejection.

7. Claims 1-7 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 2,622,991 (hereinafter the " '991 Patent"), in view of U.S. Pat. No. 4,255,480 (hereinafter the " '480 Patent").

Present independent claim 1 recites a heat and pressure consolidated laminate that comprises in superimposed relationship: a) a core layer containing at least one cellulosic sheet impregnated with a thermosetting resin; and b) a first decorative layer consisting essentially of a leather material.

Present independent claim 7 recites a heat and pressure consolidated laminate, comprising in superimposed relationship: a) a core layer containing at least one cellulosic sheet impregnated with a thermosetting phenol-formaldehyde resin, said cellulosic sheet having a resin content ranging from about 25 percent to about 35 percent; b) a first decorative layer consisting essentially of a leather material, said first decorative layer is bonded leather having a sheet thickness ranging from about 0.2 mm to about 4.0 mm; and c) an overlay layer disposed on a side of said first decorative layer opposite the core layer, said overlay layer being at least one sheet of alpha cellulose paper impregnated with a melamine formaldehyde resin.

The '991 Patent, in contrast, discloses a process for printing on *thermoplastics*; i.e., a disclosure directed toward solving the problem of "applying paint or similar coating layers to *thermoplastic materials*". (Col. 1, lines 14-16; emphasis added). The invention, according to the '991 Patent, is a process for printing on thermoplastics, and in particular thermoplastic materials of the acrylic type that may be superimposed or interposed with a layer(s) of material "which may itself be printed, coloured, or coated, and which may be of non-plastic character; examples of the material which may be used are paper, textiles, leather...". (Col. 1, lines 7-13 and 27-36). (Col. 1, lines 7-13).

In particular, the Examiner in the Official Action contends that the '991 Patent teaches a laminate comprising one or more layers of a thermoplastic material with superposed or interposed layers of a non-thermoplastic layer, such as leather, **"wherein the thermoplastic layer is made of paper or wood impregnated with acrylic solution (see paragraph bridging col. 1-2)."** (Official Action, pg. 3; emphasis added). The Examiner in the Official Action then concludes that "Sturm differs from the presently claimed invention in that the reference teaches the paper sheet impregnated with an acrylic solution, instead of a thermosetting resin." (Official Action, pg. 3).

Upon a careful reading of the '991 Patent (i.e., the "Sturm" reference), the Examiner's contention, emphasized above, as to what the '991 Patent teaches is incorrect. It follows from this incorrect assessment regarding the teaching of the '991 Patent that the examiner's conclusion as to how the '991 Patent differs from the claimed invention is also incorrect. The '991 Patent clearly does not teach that the thermoplastic layer is made of paper or wood. Instead, the '991 Patent teaches two separate types of embodiments – a non-laminated embodiment and a laminated embodiment. The non-laminated embodiment, illustrated in FIGs. 1 and 2 of the '991 patent, comprises a "core" layer made of a thermoplastic acrylic material. This thermoplastic material clearly is not disclosed or suggested in the '991 Patent to be paper, wood, leather or some other, non-thermoplastic material. Further, the laminated embodiments of FIGs. 3 and 4 of the '991 Patent also comprise the thermoplastic acrylic material as the "core" layer, and also include a "further sheet 12" as illustrated in FIG. 3, or "a layer 13 of material such as paper, and a further layer 14 of acrylic thermoplastic material" as illustrated in FIG. 4. (Col. 5, lines 31-40).

Thus, throughout all embodiments taught by the '991 Patent, the "core" layer is a thermoplastic acrylic material, while a non-thermoplastic material is taught by the '991 Patent in its laminated embodiment to only be a layer laminated to the core layer. This is in stark contrast to claims 1 and 7 of the present patent application which both recite the feature that the core layer contains at least one cellulosic sheet, which inherently is a non-thermoplastic material. As a result, there exists a greater difference between the teachings of the '991 Patent than that put forth by the Examiner in the Official Action. That is, the

Examiner's contention that the '991 Patent teaches the paper sheet impregnated with an acrylic solution, instead of a thermosetting resin, is simply incorrect.

It follows from the foregoing that the '991 Patent is not properly combinable with the '480 Patent to meet the limitations of claims 1-7 of the present application. This is primarily because of the failure of the '991 Patent to teach the thermoplastic layer being made of paper or wood, as incorrectly alleged in the Official Action.

Further, the thermoplastic materials disclosed within the '991 Patent are not the same as or equivalent to the thermosetting resin recited within claim 1. In the response of July 19, 2005, applicant provided definitions of "thermosetting plastics" and "thermoplastic" that clearly illustrate the difference between the two materials. In fact, there is no disclosure or suggestion within the '991 Patent of a core layer containing a cellulosic sheet impregnated with a thermosetting resin, and in particular a thermosetting resin such as phenol-formaldehyde.

To arrive at the claimed laminate, the Examiner indicates that the '480 Patent discloses core sheets impregnated with a phenol-formaldehyde, and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the core layer disclosed in the '480 Patent in the laminate of the '991 Patent. In particular, the Examiner indicates that it would have been obvious "because Scher teaches that the paper sheet impregnated with phenol formaldehyde would have made the laminate cured better under heat and pressure, and the use of a release sheet would have made the laminate easier to handle (see col. 1, lines 14-16 and 62-65)". Applicants respectfully disagree.

When an application is submitted to the Patent and Trademark Office, statute<sup>1</sup> and case law<sup>2</sup> dictates that the burden of proof is on the PTO to establish a prima facie case of obviousness.<sup>3</sup> Once the prima facie case has been established, then the burden of going forward with the evidence to rebut the prima facie case shifts to the applicant.<sup>4</sup> Only the burden of going forward with evidence to rebut shifts to the applicant, however. The burden

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<sup>1</sup> 35 U.S.C. 132.

<sup>2</sup> See In re Warner, 154 USPQ 173, 178 (C.C.P.A. 1967); In re Oetiker, 24 USPQ 2d 1443, 1447 (Fed. Cir. 1992).

<sup>3</sup> In re Piasecki, 223 USPQ 785, 788 (Fed. Cir. 1984).

<sup>4</sup> In re Carleton, 202 U.S.P.Q. 165, 168 (CCPA 1979).

of persuasion remains with the PTO.<sup>5</sup> In this instance, a prima facie case would necessarily have to first establish that the combined teachings of the '991 and '480 Patents render the claimed subject matter obvious<sup>6</sup>, and second provide a suggestion or motivation within the cited references to combine the cited references to arrive at the claimed invention.<sup>7</sup> The suggestion or motivation to combine the references must not be a hindsight reconstruction of isolated disclosures within the prior art.<sup>8</sup> Indeed, the lack of an appropriate motivation or suggestion to combine gives rise to an inference that the combination is the product of hindsight.<sup>9</sup>

The passages cited by the Examiner<sup>10</sup> do not support the rejection. The fact that the '480 Patent discloses: 1) a conventional core comprised of a plurality of layers of paper impregnated with a thermosetting resin; and 2) the use release sheets; does not provide a suggestion or motivation to combine the references to arrive at the claimed laminate. The '991 Patent discloses a process for printing on thermoplastics. In some embodiments, an ink or other printing material is applied to an acrylic sheet. In other embodiments, a layer of material 13 (e.g., paper) is disposed between thermoplastic layers (e.g., see FIG. 4). In all embodiments within the '991 Patent the core layer comprises a thermoplastic material and not a cellulosic material, as recited in independent claims 1 and 7. The '480 Patent, on the other hand, discloses an abrasion resistant

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<sup>5</sup> Ashland Oil v. Delta Resins and Refractories, Inc., 227 U.S.P.Q. 657, 659 (Cir. Fed. 1985). See also In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Cir. Fed. 1992): "In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. '[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.' The patent applicant may then attack the Examiner's prima facie determination as improperly made out, or the applicant may present objective evidence tending to support a conclusion of nonobviousness.".

<sup>6</sup> In re Wood, 202 USPQ 171, 174 (C.C.P.A. 1979) citing In re Bozek, 163 USPQ 545, 549-550 (C.C.P.A. 1969).

<sup>7</sup> ACS Hosp. Systems, Inc. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984), "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can only be combined if there is some suggestion to do so."

<sup>8</sup> In re Fritch, 23 USPQ2d 1780 (Fed. Cir. 1992), "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention", quoting In re Fine, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

<sup>9</sup> In re Rouffet, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998).

<sup>10</sup> Col.1, lines 14-16: "High pressure decorative laminates are conventionally produced by stacking and curing under heat and pressure a plurality of layers of paper impregnated with various thermosetting resins." Lines 62-65: "in actual practice, two laminated stacks are pressed back to back, separated by a coated release sheet that allows the laminates to be peeled apart after separation."

laminate that includes a core sheet layer combined with a pattern sheet. One of the objects of the '480 Patent is to provide a high-pressure decorative laminate that does not contain an overlay sheet. (Col.5, lines 39-41). The combination proposed by the Examiner would have acrylic sheets disposed outside of the "core layer", which configuration is contrary to the teachings of the '480 Patent. Consequently, the '480 Patent teaches away from the combination suggested by the Examiner. In addition, there is no release sheet claimed in the present claims 1-7. Hence, the suggested combination to arrive at the claimed laminate is without merit, and appears to be the product of impermissible hindsight.

In the Official Actions of 8/5/2005 and 1/24/2006, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Applicants agree. In the present case, the Examiner states that the '480 Patent teaches a laminate comprising a core layer of paper sheet impregnated with phenol-formaldehyde. "Thus, Scher is used to illustrate that paper sheet impregnated with phenol-formaldehyde has been taught in the prior art". (8/5/2005 Official Action, page 6; 1/24/2006 Official Action, page 5). There is no dispute that the '480 Patent discloses a core layer that includes kraft paper impregnated with a phenolic resin. The fact that the '480 patent discloses a kraft paper impregnated with a phenolic resin does not, however, provide a suggestion or motivation to combine the teachings of the references.<sup>11</sup> As stated above, the '480 Patent actually teaches away from the combination proposed by the Examiner.

In addition to the above, claims 3 and 7 recite a decorative layer comprising bonded leather. There is no disclosure in either reference regarding the use of bonded leather. Applicants respectfully direct the Examiner to pages 1 and 2 of the present application wherein the disadvantages of natural leather (e.g., shrinkage, defects, size limitations, etc.) and the advantages of bonded leather (e.g., negligible shrinkage, pre-prepared product, no stretching required, virtually no size limitations, etc.) are described. As the present application describes, the differences between natural and bonded leather

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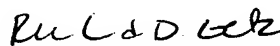
<sup>11</sup> See Footnote 8.

are significant for the uses described. For at least these reasons, applicants respectfully submit that the subject matter claimed in claims 3 and 7 is not obvious in view of the cited references.

Claim 7 also recites a core layer containing a cellulosic sheet having a resin content ranging from about 25 percent to about 35 percent. Neither the '480 Patent nor the '991 Patent disclose or suggest a cellulosic core sheet having a resin content ranging from about 25 percent to about 35 percent.

As applicant has traversed the rejection made by the Examiner, it is respectfully requested that the stated rejection be withdrawn, claims 1-7 and 22-33 be allowed, and the present application be passed onto issuance. The requisite fee for the Request of Continued Examination is provided herewith. No additional fee is believed due with the present application. In the event a fee is due, please charge our Deposit Account No. 50-3381.

Respectfully submitted,



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